

24 MAR 2005

#4



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

000513
WENDEROTH, LIND & PONACK, L.L.P.
2033 K Street N.W.
Suite 800
Washington, DC 20006-1021

In re Application of :
DYK, Andre Van :
U.S. Application No.: 10/500,705 :
PCT No.: PCT/ZA02/00211 :
Int. Filing Date: 17 December 2002 :
Priority Date: 03 January 2002 :
Attorney's Docket No.: 2004_1032A :
For: EXPLOSIVE PRESSURE WAVE :
CONCENTRATOR :

DECISION

The decision is in response to the "Petition Under 37 C.F.R. § 1.47(b)" ("Pet.") submitted on 01 February 2005.

BACKGROUND

On 01 November 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a \$65.00 surcharge fee was required. Petitioners were given two-months to respond with extensions of time available pursuant to 37 CFR 1.136(a).

On 01 February 2005, the 37 CFR 1.47(b) applicant submitted the instant petition which was accompanied by, *inter alia*, a \$200.00 petition fee; a \$65.00 surcharge fee; a one-month extension fee of \$60.00; a copy of a letter dated 06 December 2004 ("Exh. A"); copies of letters and an email sent to the nonsigning inventor ("Exh. B"); a copy of an Assignment signed by the nonsigning inventor ("Exh. C"); and a copy of a declaration signed by the 37 CFR 1.47(b) applicant ("Exh. D").

DISCUSSION

A petition under 37 CFR 1.47(b) requires (1) the petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be located, (3) a statement of the last known addresses of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

The appropriate petition fee has been paid. The last known address of the sole inventor, Andre van Dyk, is listed as:

223 Eland Street
Wierda Park
Centurion
0002 Pretoria
South Africa

Regarding item (4), the 37 CFR 1.47(b) applicant provided declaration listing the name, residence, mailing address and citizenship of the sole inventor and signed by Edward Tota, General Manager of NXCO International Limited. Section 409.03(b) of the MPEP states that "[w]here the oath or declaration is being signed on behalf of an assignee, see MPEP § 324."

Section 324 of the MPEP states, in part:

The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. The submission under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):

(A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. 37 CFR 3.73(b)(2)(ii) . . . A person having a title (**manager**, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. 37 CFR 3.73(b)(2)(i).

The position of General Manager is not a position that is assumed to have the authority to sign for the assignee. However, the 37 CFR 1.47(b) applicant declares that "Mr. Tota is an authorized representative of the corporation." Pet. at ¶ 5. The declaration complies with 37 CFR 1.497(a) and (b). This is sufficient to satisfy item (4).

With regard to item (6), section 409.03(g) of the Manual of Patent Examining Procedure (MPEP) states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." In the petition, the 37 CFR 1.47(b) applicant includes

such a statement. *Id.* at ¶ 5.

Thus, items (1), (3), (4) and (6) of 37 CFR 1.47(b) are completed.

Concerning item (2), the 37 CFR 1.47(b) applicant claims that the sole inventor has not responded to letters and an email requesting cooperation in the subject application. Section 409.03(d) of the MPEP discusses the requirements needed to show that an inventor refuses to join in an application and states, in part:

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Here, the 37 CFR 1.47(b) applicant has provided evidence that a complete copy of the application, including specification, claims and drawings was sent via email to Mr. van Dyk. Other correspondence was also sent to the last known address of Mr. van Dyk. The petitioner provided copies of these letters and the email as required by MPEP § 409.03(d). Petitioner declares that despite these attempts "no response has been received from Mr. van Dyk." *Id.* at ¶ 3. No other evidence was presented.

To show that a nonsigning inventor's conduct constitutes a refusal, petitioner must demonstrate that the inventor has knowledge of the application in question. Here, it is not clear whether the nonsigning inventor received the documents discussed above. There is no indication that the 37 CFR 1.47(b) applicant contacted Mr. van Dyk directly and no evidence showing that an attempt was made to determine whether the nonsigning inventor still lives at the address listed. In addition, there was no response to the email sent 17 December 2004 containing a copy of the subject application despite a statement in the email requesting Mr. van Dyk to acknowledge or reply promptly. Petitioner must show that the nonsigning inventor received the documents in question and has not responded, or demonstrate that a diligent effort was made to locate Mr. van Dyk. For these reasons, item (2) is not satisfied.

With regards to item (5), section 409.03(f) of the MPEP states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:

(A) the invention has been assigned to the applicant, . . .

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324).

The 37 CFR 1.47(b) applicant claims proprietary interest in the above-captioned national stage application of PCT/ZA02/00211 through an assignment. Petitioner submitted a copy of an assignment dated 05 December 2002 executed by the sole inventor which assigned: (a) the patent application (PCT/ZA02/00211); (b) the invention; and, (c) the right to apply for patents in respect to the invention the assignment taking effect on the filing date of the patent application to NXCO International Limited (the 37 CFR 1.47(b) applicant).

The assignment clearly indicates that the 37 CFR 1.47(b) applicant has the requisite proprietary interest in the above-captioned application. However, a statement under 37 CFR 3.73(b) by the assignee must also be submitted. See MPEP § 409.03(f). As such, item (5) is not yet satisfied.

All of the requirements of 37 CFR 1.47(b) are not yet complete.

CONCLUSION

Applicant's petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time are available.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302